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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,920	07/09/2001	Robert J. Mos	01-SEM/108 DIV B	8617
22890	7590	02/07/2006	EXAMINER	
RICHARD D. CLARKE LAW OFFICE OF RICHARD D. CLARKE 3755 AVOCADO BLVD., #1000 LA MESA, CA 91941-7301			PARTHASARATHY, PRAMILA	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/901,920

Applicant(s)

MOS ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47, 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This action is in response to the communication filed on 12/19/2005. In response to the office action mailed on 6/21/2005, Claim 47 was amended. New claim 48 was added. Claims 47 and 48 are currently pending.
2. Terminal disclaimer filed on 12/19/2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US copending application 09/901846 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Amended Claim 47 and new Claim 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 9 of U.S. Patent 6,260,146.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 47 and 48, correspond to the claims of 1 – 9 of the Patent 6,260,146 claims, except in the instant claims a memory device having data encrypted with a signature derived from a series of arbitrary spatial relationships of spatially encoded data; a medium incorporating a spatially encoded memory device, fixed to the exterior of the hybrid chip card, for the purpose of storing said spatially encoded data; and a processing element that uses said signature to access the encrypted data in said memory device and generating jitter signature from a first portion of information stored within a magnetic stripe on a hybrid chip card; and encoding said jitter signature in a second portion of the information stored within said magnetic stripe by jitter modulation, whereby said jitter modulation is accomplished by advancing or delaying the encoding timing by a small multiple of the reference value is referred in the Patent 6,260,146 claims as spatially encoding data on a storage medium means; providing a second memory means; determining the distance between a first

point and a second point on said storage medium whereby the first point and second point are detected by said leading and trailing read head spaced apart by a known distance; calculating a signature associated with the distance between arbitrary pairs of points on said storage medium; encrypting the information stored on said memory means using the calculated signature as the encryption key; and a chip card containing data encoded with a encryption key generated from said signature. It would have been obvious to one having ordinary skill in the art to recognize that a signature derived from a series of arbitrary spatial relationships of spatially encoded data and generating jitter signature from a first portion of information stored within a magnetic stripe on a hybrid chip card; and encoding said jitter modulation can be spatially encoding data on a storage medium means; calculating a signature associated with the distance between arbitrary pairs of points on said storage medium (with spatially encoded data) and a chip card containing data encoded with a encryption key generated from said signature.

4. Amended Claim 47 and new Claim 48, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 26 of U.S. Patent 5,770,846. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of Amended Claim 47 and new Claim 48, correspond to the claims of 1 – 26 of the Patent 5,770,846 claims, except in the instant claims a memory device having data encrypted with a signature derived from a series of arbitrary spatial relationships of spatially encoded

data; a medium incorporating a spatially encoded memory device, fixed to the exterior of the hybrid chip card, for the purpose of storing said spatially encoded data; and a processing element that uses said signature to access the encrypted data in said memory device and generating jitter signature from a first portion of information stored within a magnetic stripe on a hybrid chip card; and encoding said jitter signature in a second portion of the information stored within said magnetic stripe by jitter modulation, whereby said jitter modulation is accomplished by advancing or delaying the encoding timing by a small multiple of the reference value is referred in the Patent 5,770,846 claims as a first read apparatus; a second read apparatus spaced a predetermined distance from the first read apparatus; a counter for measuring a Reference Value which elapsed between detection of the first point and the first read apparatus and detection of the first point at the second read apparatus, and for measuring a Jitter Value which elapsed between detection of the first point at the first read apparatus and detection of the second point at the second read apparatus; a processing device for determining the quotient of the Jitter Value divided by the Reference Value and generating a Jitter signature from the Jitter Ratios; calculating the distance between the first and second points includes the step of multiplying the Jitter Ratio by the distance between the leading and trailing read apparatus. It would have been obvious to one having ordinary skill in the art to recognize that claims a memory device having data encrypted with a signature derived from a series of arbitrary spatial relationships of spatially encoded data; a medium incorporating a spatially encoded memory device, fixed to the exterior of the hybrid chip card, for the purpose of storing said spatially

encoded data; and a processing element that uses said signature to access the encrypted data in said memory device and generating jitter signature from a first portion of information stored within a magnetic stripe on a hybrid chip card; and encoding said jitter signature in a second portion of the information stored within said magnetic stripe by jitter modulation, whereby said jitter modulation is accomplished by advancing or delaying the encoding timing by a small multiple of the reference value can be spatially encoding data on a storage medium means; calculating a signature associated with the distance between arbitrary pairs of points on said storage medium (with spatially encoded data) and a chip card containing data encoded with a encryption key generated from said signature.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 47 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amended independent Claim 47 and new Claim 48 read, "... hybrid chip card..." and Claim 48 further reads, "... encoding said jitter signature in a second portion of the information stored within a magnetic stripe on a hybrid chip card ...".

With respect to "hybrid chip card", although the specification discloses, "Fig. 6b is an functional block diagram of an alternative embodiment of the present invention, in which a medium (652), such as a magnetic stripe, is fixed to the exterior of a chip card (650)", see instant specification paragraph [0061]. The specification does not indicate "hybrid chip card (contact or contactless functionality incorporated into a single card design, wherein the card contains either 2 chips with separate interfaces or a single processor supporting multiple interfaces).

With respect to "a second portion of the information stored within a magnetic stripe on a hybrid chip card", although the specification discloses, "The present invention can be used to secure such a magnetic stripe by generating a Jitter Signature encoded using Jitter Modulation in a second portion of the information", see instant specification paragraph [0063]. The specification does not indicate "a second portion of the information stored within a magnetic stripe on a hybrid chip card".

Applicant amendment does not clarify "hybrid chip card" or "a second portion of the information stored within a magnetic stripe on a hybrid chip card" and directs to specification at paragraphs [0062 and 0063], which do not disclose "hybrid chip card" or "a second portion of the information stored within a magnetic stripe on a hybrid chip card".



***Response to Arguments***

6. Applicant's arguments see Remarks pages 5 – 7, filed 12/19/2005, with respect to Claims 47 and 48 have been fully considered and are persuasive. The 35 USC 102(b) rejection of Claim 47 has been withdrawn.

***Allowable Subject Matter***

7. Claims 47 and 48 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy  
February 02, 2006.

  
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